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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,817	01/16/2004	George Garrity	MSU-08334	8033
23535 7590 04/02/2009 MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105				
			EXAMINER ZEMAN, MARY K	
			ART UNIT 1631	PAPER NUMBER
			MAIL DATE 04/02/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,817

Applicant(s)

GARRITY ET AL.

Examiner

Mary K. Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-24 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendments and response filed 12/16/08 have been entered and fully considered.

The declaration of Dr G. Garrity under 37 CFR 1.132 filed 12/16/08 is sufficient to overcome the rejections of claims 1-18 based upon Lilburn and Cole.

Claim Objections

Claim 24 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13 and 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant has amended the claims and provided arguments in regards to the previous rejection under 35 USC 101. The following rejection accounts for these amendments and arguments, as well as the new interpretations set forth in *In re Bilski*. As the grounds of this rejection are being restated, this action is non-final.

With regards to claim 1, the claim has been amended to recite that the method provides an electronically accessible network, a processor configured to provide service software and a plurality of names for a given entity. Then, the method identifies ambiguities, assigns a specific identifier, and stores the information which can be accessed through the service software of the

processor. This method is non statutory. The claim does not meet the machine-or-transformation test set forth by the court.

Bilski: "The Supreme Court has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See *Benson*, 409 U.S. at 70; *Diehr*, 450 U.S. at 192; see also *Flook*, 437 U.S. at 589 n.9; *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)."

While the method claim recites providing a processor, this processor does not appear to be a *specific* machine or apparatus. The processor is not used to perform the later method steps, and appears to provide third party service software that is not critical to the practice of the invention.

As set forth in *Bilski*: "Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590."

The method of claim 1 does not provide a transformation of matter.

With regard to claim 17, while the claims recites a system comprising a processor and software for implementing the method of claim 1, said processor and software are not sufficient to meet the machine or transformation test for the reasons cited for claim 1.

With regard to claim 18, this method fails to meet any part of the machine or transformation test. Claim 18 is drawn to a method of providing services through providing data objects, providing unique identifiers, making said identifiers accessible and routing users to third party information. The method is not linked to any specific machine or apparatus. The method does not provide a transformation of matter. With regard to the services or third party links,

Bilski provides the following: “Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.”

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment of the claim to add “and a globally Unique Persistent Identifier (GUID)” is new matter. Applicant did not point to specific basis in the specification as filed for this new limitation, and none is apparent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7-11, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Stewart (2000).

Stewart et al. (Dissertation Abstracts International, (2000) Vol. 61, No. 9B, p. 4830) discloses systems and methods for resolving named entities through persistent uniquely identified information objects. These objects are generated through processors in a network which provide resolution of names and assign objects, which are then stored. See the entirety of section 3, which discusses known PURL, DOI, URN, URI and other content identifiers. The networks are accessible by third parties, and may be maintained by a registration agency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6, 12, 13, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (2000) as applied to claims 1, 7-11 and 17, in view of Remsen (2003).

Stewart et al. (Dissertation Abstracts International, (2000) Vol. 61, No. 9B, p. 4830) discloses systems and methods for resolving named entities through persistent uniquely identified information objects. These objects are generated through processors in a network which provide resolution of names and assign objects, which are then stored. See the entirety of section 3, which discusses known PURL, DOI, URN, URI and other content identifiers. The networks are accessible by third parties, and may be maintained by a registration agency. Stewart therefore discloses the same methods and systems for providing a name resolution service comprising processors, databases, and resolution scripts. Stewart does not specifically contemplate biological data, but notes that these structures can be used for any data.

Remsen et al (US 2003/0167283) provide a universal organism name resolution and classification system. This system is an object oriented database for resolving names and classification of organisms. Biocentric information (scientific name, trivial name, properties, identifying characteristics, as well as third party information) is used in the system. The system is used to provide taxonomic services. Organismal name information is provided, and a particular object is assigned to that name. Using the object, the name is matched or correlated with stored information to provide a taxonomic name and organizational assignment in a hierarchy. The system uses Taxon tables and a classification table. The Taxon table consists of taxon identifiers, a name table where each entry is associated with a taxon identifier and a classification table. A taxon is associated with semantic data and syntactic data. Data sources can be static or dynamic, and may be third party data sources.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have applied the information architecture structures and methods of Stewart to the biological names as set forth by Remsen. It was well known in the art at the time of the invention that naming of biological data was complex. One of skill in the art would have been motivated to provide persistent, addressable information objects for biological named materials to overcome this complex naming problem. One of skill in the art would have had a reasonable expectation of success at implementing the architecture and object assignment to the information in Remsen as the same computer and database programming skills are required. Therefore, the invention would have been prima facie obvious to one of skill in the art absent evidence to the contrary.

Claims 4 and 5 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (2000) as applied to claims 1, 7-11 and 17, in view of Cornell (2003)

Stewart et al. (Dissertation Abstracts International, (2000) Vol. 61, No. 9B, p. 4830) discloses systems and methods for resolving named entities through persistent uniquely identified information objects. These objects are generated through processors in a network which provide resolution of names and assign objects, which are then stored. See the entirety of section 3,

which discusses known PURL, DOI, URN, URI and other content identifiers. The networks are accessible by third parties, and may be maintained by a registration agency. Stewart therefore discloses the same methods and systems for providing a name resolution service comprising processors, databases, and resolution scripts. Stewart does not specifically contemplate biological data, or gene and protein related data but notes that these structures can be used for any data.

Cornell et al. (Yeast 2003, 20:1291-1306) discloses the GIMS integrated data storage and analysis system. This system creates an order from data objects provided by a user. Each data object/name provided by the user is given a unique addressable identifier (object) which is stored and manipulated to create ontologies, and taxonomies. The system is specifically for biological molecules, genes, proteins, sequences etc. The system can incorporate third party information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have applied the information architecture structures and methods of Stewart to the biological names, and entities as set forth by Cornell. Cornell identifies biological name entity problems present in the art at the time of the invention. One of skill in the art would have been motivated to provide persistent, addressable information objects for biological named materials to overcome this complex naming problem. One of skill in the art would have had a reasonable expectation of success at implementing the architecture and object assignment to the information in Cornell as the same computer and database programming skills are required. Therefore, the invention would have been prima facie obvious to one of skill in the art absent evidence to the contrary.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (571) 272 0723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjie Moran can be reached on (571) 272 0720. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Art Unit: 1631

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/Mary K Zeman/

Primary Examiner, Art Unit 1631